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In re Application of WOOLFE et al.
Application No.: 10/516,943
PCT No.: PCT/GB03/02669
Int. Filing: 20 June 2003
Priority Date: 22 June 2002
Attorney Docket No.: 00303/US
For: PHARMACEUTICAL COMPOSITION

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: DECISION ON
:
: RENEWED PETITION
:
: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 26 June 2006, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliot. Applicant's request for a two month extension of time is granted.

BACKGROUND

On 16 December 2004, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 17 May 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 17 November 2005, applicant filed a petition under 37 CFR 1.47(a), along with a declaration, executed by the joint inventors on behalf of the nonsigning inventors. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliot, alleging that Ms. Allen refuses to sign the application and Mr. Elliot is unavailable.

On 24 February 2006, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant indicating that Petitioner had not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen and that diligent efforts to locate Mr. Elliot were not pursued and documented.

On 26 June 2006, applicant filed a renewed petition under 37 CFR 1.47(a) with a request for a two month extension of time.

DISCUSSION

As previously stated, a petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1), (3) and (4) were previously satisfied.

Inventor Allen's Refusal to Sign

With respect to Item (2)¹ above, a copy of Simone Frankel's 7 December 2004 letters to Ms. Allen and Mr. Elliot requesting their respective signatures on the application were produced, along with Ms. Frankel's first hand statement detailing her efforts to contact the inventors. Ms. Frankel is the Personal Assistant to the European Director-Intellectual Property for Norton Healthcare Limited. It is clear from Ms. Frankel's letters that *only* a declaration, assignment and power of attorney were presented to the inventors.² The inventors must be presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed.

Petitioner also provided the affidavit of David William Cottam, Intellectual Property Counsel for Norton Healthcare Limited detailing his efforts to contact the nonsigning inventors. Mr. Cottam states that on 22 June, 24 June and 27 June 2005, he attempted to contact Jacqueline Allen on her cell phone, leaving messages with each call. Finally, on 08 August 2005, Ms. Allen answered her cell phone. After Mr. Cottam explained the need for her to sign documents sent in December 2004, Ms. Allen indicated that "she wanted independent legal advice about her rights". On 9 August 2005, Mr. Cottam sent a copy of the patent application, declaration and power of

¹ A declaration of counsel Michael Steinberg, which was not a statement of first hand knowledge and did not provide details of the attempts made or diligent efforts to contact the nonsigning inventors, was provided with the 17 November 2005 petition. Mr. Steinberg stated that a copy of the patent application along with declaration was sent to Ms. Allen by Simone Frankel. However, Ms. Frankel's letters and her first hand statement of facts were not provided with the petition and are now appended to the renewed petition.

² A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).....

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

attorney via Royal Mail including a listing of patent attorneys in the London area. A copy of this letter was attached to Mr. Cottam's statement. The correspondence was returned to Mr. Cottam on 3 September 2005 marked "refused". This is sufficient evidence to conclude that Ms. Allen refuses to sign the application papers.

Unavailability of Inventor Elliot

With respect to counsel's inability to find or reach Mr. Elliot, Ms. Frankel's affidavit states that on 7 December 2004, she sent a letter by registered post to Mark Clifford Elliot at his last known address of 40 Farleigh Road, Stoke Newington, London N16 7 TH. She further indicates that the letter to Mark Elliot was returned as undeliverable at the aforementioned address.

In his affidavit, Mr. Cottam relates that "he asked Mr. Elliot's former colleagues regarding Mr. Elliot's whereabouts and learned that "Mark Elliot was living in a tent somewhere on the South coast of England and was moving around the countryside as he wished." This is hearsay evidence regarding the whereabouts of Mr. Elliot.

Sufficient diligent efforts made to locate Mr. Elliot were not pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer(s) or joint inventor(s) to obtain a forwarding address or a request from the Postal Service for his forwarding address. Where inability to find or reach a nonsigning inventor "after diligent effort"³ is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that a further search for Mr. Elliot's new address was made. Since attempts to locate inventor Elliot were insufficient, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor. The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it cannot be concluded that Mr. Elliot is unavailable to sign the application.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. With regard to Item (2), Petitioner has demonstrated that Ms. Allen refuses to sign the application. However, Petitioner has not satisfied Item (2) with respect to Mr. Elliot, that is, that "diligent efforts" were made to contact the nonsigning inventor Mark Clifford Elliot. Petitioner should pursue further efforts in a diligent attempt to locate Mr. Elliot before it can be concluded that Mr. Elliot is unavailable. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

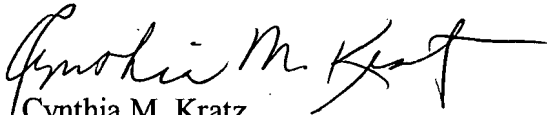
CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

³ As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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